## REMARKS/ARGUMENTS

In the Office Action mailed December 19, 2007 (hereinafter, "Office Action"), claims 1-4, 8, 9, 11-14, 18, 19, 21-23, 27 and 28 stand rejected under 35 U.S.C. § 103. Claims 1, 12 and 21 have been amended.

Applicants respectfully respond to the Office Action.

### I.     Claims 1-4, 8, 9, 11-14, 18, 19, 21-23, 27 and 28 Rejected Under 35 U.S.C. § 103

Claims 1-4, 8, 9, 11-14, 18, 19, 21-23, 27 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,142,318 to Lopez et al. (hereinafter, "Lopez") in view of U.S. Patent No. 7,173,724 to Nomura et al. (hereinafter, "Nomura"). Applicants respectfully traverse.

The factual inquiries that are relevant in the determination of obviousness are determining the scope and contents of the prior art, ascertaining the differences between the prior art and the claims in issue, resolving the level of ordinary skill in the art, and evaluating evidence of secondary consideration. KSR Int'l Co. v. Teleflex Inc., 550 U.S. ___, 2007 U.S. LEXIS 4745, at **4-5 (2007) (citing Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966)). To establish a *prima facie* case of obviousness, the prior art references "must teach or suggest all the claim limitations." M.P.E.P. § 2142. Moreover, the analysis in support of an obviousness rejection "should be made explicit." KSR, 2007 U.S. LEXIS 4745, at **37. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." Id. (citing In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Applicants respectfully submit that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the subject matter in these claims.

Claim 1 as amended recites "printing a proof sheet by the scanner, wherein said proof sheet is representative of the scan job." Support for this amendment can be found in Applicants'

specification on at least page 5, lines 17-18. Lopez, alone or in combination with Nomura, does not

teach or suggest this subject matter.

Instead Lopez states:

> Referring now to the drawings, there is illustrated a printing system constructed in accordance with the present invention which enables digital images associated with Internet web pages to be previewed, selected, and printed without the need for a computer attached to the printer. The printing system preferably includes subsystems which obtain certain image files associated with a specified web page, print a proof sheet associated with those images, allow the user to select which of the images are to be printed, and print these user-selected image files.

Lopez, col. 3, lines 40-49.

Lopez thus describes "digital images associated with Internet web pages" and "print[ing] a

proof sheet associated with those images." Lopez further states that "the proof sheet 22 includes an

indicia 52 (such as a thumb-nail image and/or a filename) for each qualified image file 3, and a user-

designation area 54 associated with each indicia 52." (Lopez, col. 4, line 66 – col. 5, line 2).

Lopez also states:

> After the user chooses selected ones of the qualified image files 2 for printing by marking the user-designation areas 54 associated with the indicia 52 of the selected image files 2, the user places the marked proof sheet 22 on a scan platen [sic] 122 where it is optically scanned by a scanner subsystem 82. The proof sheet analyzer subsystem 82 detects and interprets the markings made by the user in the user designation areas 54 (also known as image selection areas 54) to identify the user-selected image files 2, and associates each of the individual user designation areas 54 with a corresponding image file URL 73 via the identity marker 60. The proof sheet analyzer subsystem 82 then provides the image file URLs 73 to the internet access subsystem 70 in order to obtain the user-selected image files 2 from the network 205. When the image files 2 have been retrieved, the proof sheet analyzer 82 sends them to an image printing subsystem 84 along with the printing instructions marked by the user in the user-designation area 54 for each image file.

Lopez, col. 5, lines 8-27.

Thus, "the marked proof sheet" is "optically scanned by a scanner subsystem" to "detect[] and interpret[] the markings made by the user in the user designation areas." Consequently, the "marked proof sheet" is printed before it is scanned by the "scanner subsystem." Therefore, the "marked proof sheet" of Lopez is not the same as the "proof sheet" of the present application, "wherein said proof sheet is representative of the scan job" because the "marked proof sheet" of Lopez is not and can not be "representative of the scan job" since the "marked proof sheet" of Lopez is printed before it is scanned as a "scan job." Thus, Lopez does not teach or suggest "printing a proof sheet by the scanner, wherein said proof sheet is representative of the scan job." The addition of Nomura does not overcome the deficiencies of Lopez.

The Office Action has not cited, nor can Applicants find any mention of or reference to a "proof sheet" in Nomura. Furthermore, the Office Action has not cited, nor can Applicants find any portion of Nomura that teaches or suggests "printing a proof sheet by the scanner, wherein said proof sheet is representative of the scan job." Nomura describes a scanner that "has an auto reading mode and manual reading mode. In the auto reading mode, sheet-shaped documents are automatically fed by the automatic document feeder 4, and scanned sheet-by-sheet to be exposed, so as to read document images." (Nomura, col. 8, lines 26-30). However, describing a scanner that can "read document images" does not teach or suggest "printing a proof sheet by the scanner, wherein said proof sheet is representative of the scan job."

Claim 1 as amended also recites "receiving user input corresponding to the proof sheet through the user interface at the scanner, wherein the user input comprises one of the following: (a) input to approve the scan job, (b) input to rescan the plurality of pages, (c) input to edit settings for the scan job, or (d) input to cancel the scan job." Support for this amendment can be found in Applicants' specification on at least page 7, lines 15-20. Lopez, alone or in combination with Nomura, does not teach or suggest this subject matter.

The Office Action admits that "Lopez does not expressly disclose receiving user input through the user interface at the scanner, wherein the user input comprises one of the following: (a) input to approve the scan job, (b) input to rescan the plurality of pages, (c) input to edit settings for

the scan job, or (d) input to cancel the scan job." (Office Action, page 9). As discussed above, Lopez does not teach or suggest "printing a proof sheet by the scanner, wherein said proof sheet is representative of the scan job." Because Lopez does not teach or suggest a proof sheet, "wherein said proof sheet is representative of the scan job," Lopez also does not teach or suggest "receiving user input corresponding to the proof sheet through the user interface at the scanner, wherein the user input comprises one of the following: (a) input to approve the scan job, (b) input to rescan the plurality of pages, (c) input to edit settings for the scan job, or (d) input to cancel the scan job." The addition of Nomura does not overcome the deficiencies of Lopez.

Instead Nomura states:

> The various keys of the operation section 302 are namely: a start key 302a, an all clear key 302b, a clear key 302c, ten keys 302d, and a mode switching key group composing of a printing mode key 302e, an image sending key (scanning mode key) 302f, and a photocopying mode key 302g, and a job status key 302h.
> The start key 302a is a key for giving instructions to start a process of a mode set by using the various keys. The all clear key 302b clears whole setting of the image forming system 1, so as to restore a standard condition of the image forming system 1. The clear key 302c clears condition, which is inputted by the ten keys 302d and the like. The ten keys 302d are keys for inputting numerical information such as a number of sheets to be photocopied. The keys (302e, 302f, and 302g) in the mode switching key group are for switching over the modes for the process (process modes). Moreover, the job status key 302h is a display key (key for a standby job display) of a picture plane regarding a job proceeding status.

Nomura, col. 9, lines 33-52.

The Office Action has not cited, nor can Applicants find any mention of or reference to a "proof sheet" in Nomura. Furthermore, the Office Action has not cited, nor can Applicants find any portion of Nomura that teaches or suggests "receiving user input corresponding to the proof sheet through the user interface at the scanner." Nomura describes "various keys of the operation section" including "a start key 302a, an all clear key 302b, a clear key 302c, ten keys 302, and a mode switching key group composing of a printing mode key 302e, an image sending key (scanning mode key) 302f, and a photocopying mode key 302g, and a job status key 302h." However, merely having

a number of "various keys of the operation section" does not teach or suggest "wherein the user input comprises one of the following: (a) input to approve the scan job, (b) input to rescan the plurality of pages, (c) input to edit settings for the scan job, or (d) input to cancel the scan job" as suggested by the Office Action.

Nomura does not teach or suggest receiving "input to approve the scan job." Furthermore, because Nomura does not teach or suggest the use of a "proof sheet" or other means for reviewing the scan job upon completion, it follows that "input to approve the scan job" would not be necessary in Nomura since Nomura already includes a "start key." Nomura also does not teach or suggest receiving "input to rescan the plurality of pages." Because Nomura does not teach or suggest the use of a "proof sheet" or other means for reviewing the scan job upon completion, it follows that "input to rescan the plurality of pages" would not be necessary in Nomura since Nomura already includes a "start key."

For the above reasons, Lopez, alone or in combination with Nomura, does not teach or suggest "receiving user input corresponding to the proof sheet through the user interface at the scanner, wherein the user input comprises one of the following: (a) input to approve the scan job, (b) input to rescan the plurality of pages, (c) input to edit settings for the scan job, or (d) input to cancel the scan job."

Claim 1 also recites "sending the scan job to a remote computer or computer peripheral on a network if the user input was the input to approve the scan job, whereby enabling the user to proof the scan job before sending the scan job to the remote computer or the computer peripheral on the network." Lopez, alone or in combination with Nomura, does not teach or suggest this subject matter.

The Office Action admits that "Lopez does not expressly disclose sending the scan job to a remote computer or computer peripheral on a network if the user input was the input to approve the scan job, whereby enabling the user to proof the scan job before sending the scan job to the remote computer or the computer peripheral on the network." (Office Action, pages 9-10). The addition of Nomura does not overcome the deficiencies of Lopez.

Instead Nomura states:

> The display section 301 of the operation panel 300 has a default picture
> plane (standby picture plane), which is a photocopying mode picture plane as
> shown in FIG. 5. If the image sending key 302f is, for example, pushed in
> order to switch over the process mode, the process mode is switched over
> from the photocopying mode to the image sending mode. In response to this,
> the display section 301 displays a picture plane shown in FIG. 6. Here, the
> scanning mode is a process mode in which the document read by the scanner
> 3 is transmitted to a receiver. Examples of the scanning mode include fax
> communication, SCAN TO E-mail, SCAN TO FTP (FTP: File Transfer
> Protocol) and the like.

Nomura, col. 9, lines 53-64.

The above cited portion of Nomura describes operating the scanner in "image sending mode" wherein "the document read by the scanner 3 is transmitted to a receiver." However, operating a scanner in "image sending mode" including "fax communication, SCAN TO E-mail, SCAN TO FTP (FTP: File Transfer Protocol) and the like" is not "enabling the user to proof the scan job before sending the scan job to the remote computer or the computer peripheral on the network" as suggested by the Office Action. Operating the scanner in "image sending mode" is simply sending the scanned document to a receiver such as a remote computer or a fax machine. Nomura does not teach or suggest that a user is able "to proof the scan job before sending the scan job to the remote computer" or other receiver.

In view of the foregoing, Applicants respectfully submit that claim 1 is patentably distinct from the cited references. Accordingly, Applicants respectfully request that the rejection of claim 1 be withdrawn because Lopez, alone or in combination with Nomura, does not teach or suggest all of the subject matter of claim 1.

Claims 2-4, 8, 9 and 11 depend either directly or indirectly from claim 1. Accordingly, Applicants respectfully request that the rejection of claims 2-4, 8, 9 and 11 be withdrawn.

Claim 12 as amended includes subject matter similar to the subject matter of claim 1. As such, Applicants respectfully request that the rejection of claim 12 be withdrawn because Lopez, alone or in combination with Nomura, does not teach or suggest all of the subject matter of claim 12.

Claims 13, 14, 18 and 19 depend either directly or indirectly from claim 12. Accordingly, Applicants respectfully request that the rejection of claims 13, 14, 18 and 19 be withdrawn.
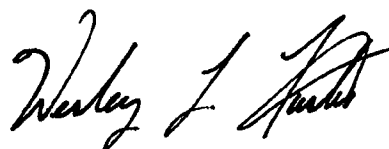
Claim 21 as amended includes subject matter similar to the subject matter of claim 1. As such, Applicants respectfully request that the rejection of claim 21 be withdrawn because Lopez, alone or in combination with Nomura, does not teach or suggest all of the subject matter of claim 21.

Claims 22, 23, 27 and 28 depend either directly or indirectly from claim 21. Accordingly, Applicants respectfully request that the rejection of claims 22, 23, 27 and 28 be withdrawn.

## II.   Conclusion

Applicants respectfully assert that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

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